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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,986	02/22/2002	Ronald A. Schachar	PRES06-00251	9951

7590 12/01/2004

Docket Clerk  
P.O. Drawer 800889  
Dallas, TX 75380

EXAMINER

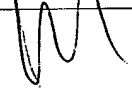
PANTUCK, BRADFORD C

ART UNIT	PAPER NUMBER
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3731

DATE MAILED: 12/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/080,986	Applicant(s) SCHACHAR ET AL. 	
	Examiner Bradford C Pantuck	Art Unit 3731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 October 2004.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 9-18 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-8 is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,342,377 to Lazerson. Regarding Claim 1, Lazerson discloses an instrument having a drive shaft (30), which is rotatably connected to a support arm (54) [see Fig. 53; Column 5, lines 3-8], which is detachably coupled to a curved cutting blade (66) [see Fig. 4]. The reader knows that the blade is detachable from the support arm in the embodiment shown in Figure 4, because Lazerson singles this embodiment out as being different from the embodiments shown in Figures 11 and 12, which have their blades and support arm “forged...as a unitary piece” [Column 4, lines 35-37].
2. Claims 1-3 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 3,609,864 to Bassett. Regarding Claim 1, Bassett discloses a rotatable support arm, comprising elements 20 and 21, as shown in Figure 2. This support arm is rotatable relative to drive shaft (30) []. Further, this support arm is generally rotatable: i.e., the user can spin (rotate) *the whole device* like a top. Finally, this support arm rotates relative to the handle (shell 28) of the device, when the user rotates handle 31 (thus turning the drive shaft 30) [Column 4, lines 4-10; Fig. 1]. A

Art Unit: 3731

curved cutting blade (24) is detachable coupled to a second end of the rotatable support arm (20/21). This cutting blade (24) is capable of being rotated in any way the user desires, including rotating the blade through body tissue such as scleral tissue.

3. Regarding Claim 2, the cutting blade is capable of making an incision having the specifications outlined by the Applicant in Claim 2. Bassett's invention is intended for surgical uses as it is entitled "SURGICAL BLADE HANDLE." The specifications of the cut size are more dependent on the skill of the surgeon than on the mechanical features of the invention. In apparatus claims more weight is given to the mechanical features claimed than on a method of using the device.
4. Regarding Claim 3, Bassett discloses a surgical blade having an extension (proximal end of blade) having a portion (inner portion of the proximal end of the blade) that has an aperture "keyhole slot 25" [see Figure 1].

#### *Allowable Subject Matter*

5. Claim 4 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
6. Claims 5-8 are allowed.

#### *Conclusion*

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

*Response to Arguments*

8. Applicant's arguments and amendment to the specification, see "REMARKS", filed October 8, 2004, with respect to the objection to the drawings have been fully considered and are persuasive. The objection to the clarity of Fig. 42 has been withdrawn.
9. Applicant's arguments filed October 8, 2004 have been fully considered but they are not persuasive. Regarding Examiners rejection of claims 1 and 2 with U.S. Patent No. 5,342,377 to Lazerson, Examiner maintains his position. Applicant argues in "REMARKS:" on page 15 that Lazerson does not disclose blade (66) being detachable from rotatable support arm (54). However, Lazerson discloses an embodiment in which the blade is "separate" from the rotatable support arm [column 4, line 30]. In other words, these two pieces form an assembly—separate parts attached to each other. Whether these two parts are attached with glue, or slots, or

with other mechanical means is irrelevant: two pieces which are attached to each other are necessarily *able to be detached*. If they are glued together then the force required *may be quite great*, but the fact remains that one would be able to separate them.

Conversely, we know that blade (60') is *not detachable* from rotatable support arm (58'/54) in the embodiment shown in Figure 11, because Lazerson declares them to be either "forged" together or formed "as a unitary piece" [Column 4, lines 35-37].

Claiming that Lazerson's cutting device would not function properly if it were detached [page 15, line 8] is irrelevant because Applicant only claims that the blade is detachable not that the device would function perfectly/be reusable after the blade is detached.

Regarding Applicant's argument that Lazerson's blade is incapable of being rotated into eye tissue [page 14, first full paragraph] Examiner disagrees. Because Lazerson's blade/rotatable arm assembly rotates about axis (70), the user could jab the distal tip (68) of the blade [Fig. 4] into tissue and then the user could turn/push drive shaft (30) causing the blade to face resistance from the eye tissue and thus rotate relative to the drive shaft (30). It is therefore *capable* of such an intended use.

10. Regarding Examiners rejection of claims 1-3 with U.S. Patent No. 5,342,377 to Lazerson, Examiner maintains his position. Bassett's blade surface is clearly capable of being held adjacent the eyeball and rotated down into eye tissue, including the sclera to form an incision capable of receiving a rectangular prosthesis. Arguing that

Art Unit: 3731

Bassett's invention cannot perform this function "properly" [REMARKS, page 17 line 4] is not pertinent: the blade is capable of cutting scleral tissue.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradford C Pantuck whose telephone number is (571) 272-4701. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anhtuan Nguyen can be reached on (571) 272-4963. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

BCP  
BCP

November 24, 2004

  
ANH TUAN T. NGUYEN  
PRIMARY EXAMINER

11/29/04